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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/446,314	12/20/1999	Yasumasa Yamakoshi	216-429P	2146
2292 7590 02/14/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER ZEMEL, IRINA SOPJIA	
			ART UNIT	PAPER NUMBER
			1711	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	02/14/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary

Application No.

09/446,314

Applicant(s)

YAMAKOSHI ET AL.

Examiner

Irina S. Zemel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-7 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2, and 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,616,652 to Kusano et al., (hereinafter "Kusano").

The rejection stands as per reason of record. Insofar as the amended claim 7, the reference, as discussed in the prior office action discloses SEPS with molecular weight of 200,000 (obtained by hydrogenation of SIS), which fully satisfies the claim limitations of claim 7.

Once again, it is emphasized that the reference expressly discloses centrifugation step as one of only two possible dehydration steps in column 6 of the reference. As such, the reference discloses extremely small genus of dehydration steps (namely only centrifugation and a compression dehydration) and one of the two possible methods would have been clearly envisaged from this expressed disclosure, even if, the centrifugation step is not exemplified in preferred embodiment.

Claim Rejections - 35 USC § 102/103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kusano..

The disclosure of the Kusano reference is discussed above. The rejection stands as per reasons of record with respect to claims 3-6. Insofar as the amended claim 1, while the reference measures the oil absorbency via a different method, it is reasonable believed that the product that is obtained by one of the expressly disclosed methods, i.e., using centrifugation as dehydration step, would necessarily and inherently exhibit the claimed properties. As noted above, the process using centrifugation is clearly envisaged from the disclosure of the reference.

Response to Arguments

Applicant's arguments filed 11-22-2006 have been fully considered but they are not persuasive. The applicants argue that the rejection under 35 USC 102 is improper since the reference does not disclose all of the limitations of claim 2. Specifically the reference does not disclose the required dehydration step that is conducted by gravity, centrifugation or filtration. The applicants go on to quote several passages from the reference that discloses and teaches that the preferred method of dehydration is conducted by mechanical squeezing. While it may be so, the applicants interpretation of the disclosure of the reference is impermissibly narrow and conveniently overlooks the entire disclosure of the reference and specific passages referred to by the examiner in the previous office action. It has been long established by the court that "The use of patents as references is not limited to what the patentees describe as their own

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inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983). Further, a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), *cert. denied*, 493 U.S. 975 (1989). See also *Upsher-Smith Labs. v. Pamlab, LLC*, 412 F.3d 1319, 1323, 75 USPQ2d 1213, 1215 (Fed. Cir. 2005) *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The court held that the prior art anticipated the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed."). Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) Furthermore, "[t]he prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

Keeping in mind all of the relevant court decisions quoted above, the applicants attention, once again, is drawn to the disclosure in column 6, lines 63-65, where the patentee expressly discloses that "in dehydration step of the first stage, the hydrous crumbs are separated from water with a centrifuge or by a compressing dehydration, such as a roll, Banbury dehydrator or a screw extrusion type dehydrator". Thus, the reference discloses only TWO alternative and suitable techniques for the dehydration step, namely centrifugation and compressing dehydration. (Even if one, for whatever reason, chooses to count each of the exemplified type of compressing dehydration, still, the reference only discloses four possible mechanism of dehydration). The genus of methods suitable for dehydration is so very small, that one would CLEARLY envisage the dehydration step conducted by one of two (four) methods, namely centrifugation, even though this particular method is not disclosed as preferred. The rejection under 35 USC 102 under this circumstances is completely appropriate.

It is further noted that the final product obtained by the method disclosed in the reference and the using one of the two (or four) discloses possible methods of dehydration that completely correspond to the claimed method would necessarily inherently exhibit all of the claimed properties as obtained from identical starting materials and by identical steps as the claimed product. Similarly, the disclosed process (using the centrifugation as a dehydration step, which, as discussed above, is clearly envisaged from the very small genus of dehydration steps) would necessarily result in the products having properties identical to the claimed product/properties.

It is noted that the argument that the reference does not disclose the required dehydration step is the ONLY argument presented by the applicants in support of the patentability of claim 2 and the only arguments alleging an error in the rejection of claim 2 issued in the previous office action. All other arguments are directed to the oil absorbency of the product. It is further noted that NONE of the method claims, i.e., 2-7 even claim the absorbency property of the product. In the previous office action, the examiner shifted the burden to the applicants to provide factual evidence that the OTHER claimed properties of the method claims are not met by the reference. The applicants neither presented any of the evidence to that fact, nor they even argued that the claimed properties of claims 2-6 are not met by the product disclosed in the reference.

With respect to the rejection of claim 1 under 35 USC 102 or, in the alternative, under 35 USC 103, the applicants argue that the disclosed dry porous crumbs would not exhibit the claimed oil absorbency property as measured by the test set in claim 1. This argument is similarly unconvincing. First of all, the fact that the oil absorption is measured differently in the reference, contrary to the applicants assertion, does not necessarily mean that it would not satisfy the claimed limitation when measured under the claimed conditions. No evidence to support applicants allegation (which is just that – allegations) are presented on the record. Even more important, the applicants compare the preferred embodiment disclosed in the reference and not the non-preferred, but clearly disclosed embodiment of centrifugation dehydration. The process using centrifugation dehydration, as discussed above (and which is clearly envisaged

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from the reference disclosure) will necessarily result in product with the claimed properties. The anticipation rejection based on inherently is clearly warranted in this case also. But even arguendo, if the disclosed product (using centrifugation step in its production) do not exhibit the claimed properties as per claim 1, the results of examples 1,2 and comparative example 3 can not be conclusively compared to each other as the drying conditions in the second step vary and it is not clear what is the determining factor for the final properties of the product. Note that none other examples discussed on several pages of response are seen as relevant since no other differences (except for the dehydration step) between the claimed and disclosed process are even alleged by the applicants.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

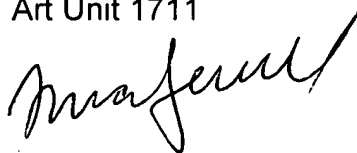
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Irina S. Zemel
Primary Examiner
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ISZ